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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/664,434	09/15/2000	Fumiaki Ueno	50355-050RI	4036

7590 08/22/2006

McDermott Will & Emery  
600 13th Street NW  
Washington, DC 20005-3096

EXAMINER
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MULVANEY, ELIZABETH EVANS

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/664,434

Applicant(s)

UENO ET AL.

Examiner

Elizabeth Mulvaney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 30-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 30-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION- *Reissue Application***

***Improper Specification***

1. The specification is objected to because of the following informality:

The format of the present specification is improper. The entire specification, including the claims, of the patent for which reissue is requested must be furnished in the form of a copy of the printed patent, in double column format, each page on only one side of a single sheet of paper. Appropriate correction is required. Refer to MPEP 1411 and 37 C.F.R. 1.173(a)(1).

***Establishing Ownership Interest***

2. The submission establishing ownership interest was signed by applicant's attorney. An attorney or agent of record is not authorized to sign a submission establishing ownership interest, unless he/she has been established as being authorized to act on behalf of the assignee. The only documentation establishing ownership located in the application file was signed by the attorney. It is recommended that applicants submit a completed Form PTO/SB/96. A copy of this form can be found in MPEP § 324.

3. It would be acceptable for a person, other than a recognized officer, to sign a submission establishing ownership interest, provided the record for the application includes a duly signed statement that the person is empowered to sign a submission establishing ownership interest and/or act on behalf of the assignee.

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Accordingly, a new submission establishing ownership interest which includes such a statement above, will be considered to be signed by an appropriate official of the assignee. A separately filed paper referencing the previously filed submission establishing ownership interest and containing a proper empowerment statement would also be acceptable.

***Defective Oath/Declaration***

4. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following: The declaration is improper in that it does not state that the person making the declaration believes they are the “original and first” inventors of the invention claimed. Applicants use the language “original and joint” inventor. See 37 CFR 1.63(a)(4).

Claims 1-21 and 30-37 are rejected as being based upon a defective reissue oath under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect in the oath is set forth in the discussion above in this Office action.

5. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 1-21 and 30-37 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above. Amendments have been made after the filing of the original declaration which have not been covered by any declaration. Applicants need to file a supplemental

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declaration to remedy this. If additional defects or errors are corrected in the reissue after the filing of the application and the original reissue oath or declaration, a supplemental reissue oath/declaration must be filed, unless all additional errors are spelling, grammar, typographical, editorial or clerical errors which are not errors under 35 USC 251 (see MPEP 1402). In other words, a supplemental oath/declaration is required where any “error” under 35 USC 251 has been corrected and the error was not identified in the original reissue oath/declaration. The supplemental reissue oath/declaration must state that every error which was corrected in the reissue application not covered by the prior oath/declaration submitted in the application arose without any deceptive intention on the part of the applicant.

Receipt of an appropriate supplemental oath/declaration under 37 CFR

1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

“Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant.”

6. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following: The declaration is improper in that it fails to list the foreign applications upon which priority is claimed.

A “claim” for the benefit of an earlier filing date in a foreign country under 35 U.S.C. 119(a)-(d) must be made in a reissue application, even though such a claim was previously made in the application for the original patent to be reissued. However, no additional certified copy of the foreign application is necessary. The procedure is similar to that for “Continuing Applications” in MPEP § 201.14(b).

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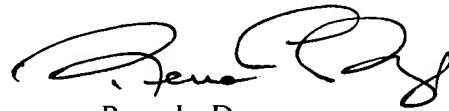
In addition, 37 CFR 1.63 requires that in any application in which a claim for foreign priority is made pursuant to 37 CFR 1.55, the oath or declaration must identify the foreign application for patent or inventors' certificate on which priority is claimed unless supplied on an application data sheet (37 CFR 1.76), and any foreign applications having a filing date before that of the application on which priority is claimed, by specifying:

- (A) the application number of the foreign application;
- (B) the foreign country or intellectual property authority; and
- (C) the day, month, and year of the filing of the foreign application.

7. Any inquiry concerning this communication or earlier communications from the examiner of record should be directed to SPE Rena L. Dye whose telephone number is 571-272-3186. She can normally be reached on Monday-Friday 9:30 AM - 6:00 PM EST. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Rena L. Dye  
SPE  
Art Unit 1774

rld  
8/11/06